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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,194	07/19/2001	Michael A. Wilkman	HOLCORP.005A	9144
20995 7590 03/08/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3622	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		03/08/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/08/2007.

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Office Action Summary

Application No.

09/909,194

Applicant(s)

WILKMAN, MICHAEL A.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-13,15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13, 15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 18 December 2006 have been fully considered but they are not persuasive. The arguments are addressed at para. 14-17 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US005644723A).
5. Meyer et al. teaches (independent claim 8) a method for managing promotions, comprising:
 - receiving, via an electronic communications medium, a plurality of promotions relating to a plurality of merchants (col. 9 lines 56-59 and col. 1 line 29);
 - receiving, via an electronic communications medium, user information relating to a plurality of *members/users*, wherein the *member/user* information includes *member/user* account information (col. 8 lines 12-19, col. 33 lines 30-39, including Fig. 27, and col. 34 lines 16-28);

matching at least one of the plurality of promotions to at least one of the plurality of *members/users* based at least upon a portion of the plurality of *member/user* information and user account information (col. 46 lines 20-42 and col. 4 lines 26-27); and

presenting to at least one of the plurality of *members/users*, via a personal computer device (col. 7 lines 55-57), information in a promotion document about the at least one of the plurality of promotions (col. 6 lines 34-43).

6. Meyer et al. also teaches at the citations given above claim 11. Meyer et al. also teaches claim 9 (col. 8 line 39) and claim 10 (col. 3 line 46 and col. 53 lines 35-43).
7. Claim 19 is rejected under 35 U.S.C. 103(a) as obvious over Meyer et al. in view of Hoffman et al. (US006397198B1). Meyer et al. does not teach user accounts configured to transfer funds. Hoffman et al. teaches user accounts configured to transfer funds (col. 3 line 63 to col. 4 line 2). Because the tokenless account access control system of Hoffman et al. further promotes commerce (col. 1 lines 25-33 and 56-60, and col. 2 lines 24-35), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Hoffman et al. to those of Meyer et al.
8. Claims 1-6, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Meyer et al.
9. Hoffman et al. teaches (independent claim 1) a system for facilitating the matching of at least one promotion with at least one user, the system comprising:
 - a merchant management module (*rewards transaction processor*) configured to manage, via an electronic communications medium, at least one promotion (*rewards*) that corresponds to at least one of a plurality of merchants (*various reward-units issuers*, col. 4 lines 28-34);
 - a personal computer device (*terminal 4*) configured to manage preferences, wherein the personal computer device is further configured to manage a plurality of user accounts for transferring funds (col. 4 line 45 to col. 5 line 9, including Fig. 1, and col. 5 lines 27-31); and
 - a transaction module (*execution module 28*) configured to present information about the at least one promotion (*transaction-related information*) to at least one user (col. 5 lines 27-31) via the personal computer device (col. 3 line 58 to col. 4 line 2), the transaction module

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further configured to select at least one of the plurality of user accounts (col. 8 lines 37-39) to use for a commercial transaction with the at least one of a plurality of merchants (col. 6 lines 15-21 and col. 7 lines 37-58).

10. Hoffman et al. does not teach that the selection is based at least in part on the at least one promotion. However, Hoffman et al. does teach that the account is selected by the user (col. 8 lines 31-39). Hence it would have been obvious for the user to make the selection based at least in part on the at least one promotion if there is any benefit to doing so (i.e., a special reward).
11. Hoffman et al. does not teach that the promotion relates to preferences that correspond to the user. Meyer et al. teaches that the promotion relates to preferences that correspond to the user (col. 6 lines 34-43 and col. 8 lines 31-37). Because Meyer et al. teaches that it is efficient to select promotions that relate user preferences (*interests and past purchasing behavior*, col. 1 lines 36-44 and 54-55), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Meyer et al. to those of Hoffman et al.
12. Hoffman et al. also teaches at the citations given above claims 4, 12 and 15. Hoffman et al. also teaches claim 5 (col. 7 lines 59-62) and claim 13 (col. 3 line 63 to col. 4 line 2).
13. Meyer et al. also teaches at the citations given above claim 6. Meyer et al. also teaches claim 2 (col. 9 lines 56-59 and col. 1 line 29) and claim 3 (col. 8 lines 12-19 and col. 34 lines

Response to Arguments

14. Applicant argues (unnumbered 5th page),

“Regarding Claim 8, Applicant respectfully submits that Meyer does not teach or suggest, among other things, ‘**matching** at least one of the plurality of promotions to at least one of the plurality of users based at least upon a portion of the plurality of user information and **the user account information**.’ The Examiner has cited Col. 46, lines 26-42 of Meyer as teaching matching at least one of the promotions to at least one of the users based at least upon user information and the user account information. Applicant respectfully submits that the cited portion merely teaches that customers from specific demographic groups may be targeted by ‘matching the customer characteristics to some of the parameters of’ an incentive. The cited portion, however, does not teach matching

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at least one of the promotions to at least one of the users based at least in part on the user account information.” (Emphasis is in the original.)

15. Applicant is not correct. Meyer et al. teaches that promotions are matched to “all the consumer data available” (col. 46 lines 28-29), which reads on matching at least one of the promotions to at least one of the users/consumers. Meyer et al. teaches that this data includes user/customer purchase history data in a *datamart* (col. 45 line 66 to col. 6 line 6, and at col. 46 lines 20-26), where said *datamart* record reads on “user account information”. In addition,

“The incentives can be targeted to specific consumers based on consumer purchase history, ...” (Meyer et al., col. 4 lines 26-27)

16. Applicant argues concerning the rejection of claim 1,

“Hoffman does not teach, suggest or relate to “promotions.” The Examiner has cited col. 4, lines 28-34 of Hoffman for this teaching. This portion of Hoffman, however, merely discloses a “reward account” that contains “reward-units.” It does not teach or suggest or relate to promotions that correspond to merchants. Accordingly, at least for this reason, Claim 1 is patentably distinct over Hoffman.” (Second para. from the bottom of the unnumbered 6th page)

Applicant is not correct. As noted in the rejection (para. 9), “rewards” reads on a promotion. This is the examiner’s broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). Especially see para. [0002] of the published application, US 20020013728A1, which suggests various kinds of rewards (*points*) in the context of promotions.

17. Applicant argues further,

“Moreover, Hoffman does not teach, suggest or relate to presenting information about a promotion. The Examiner has cited col. 3, line 58 to col. 4, line 2 of Hoffman for the assertion that Hoffman teaches a transaction module configured to present information about the at least one promotion to at least one user via the personal computer device.” (Bottom para. of the unnumbered 6th page)

The rejection citations have been edited to make the teachings in para. 9 clearer.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
21. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
23. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on

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applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

24. Applicant may have after final arguments considered and amendments entered by filing an RCE.

25. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.


22 February 2006
22 Feb 07


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